

§41.41

37 CFR Ch. I (7–1–10 Edition)

§1.111 of this title with or without amendment or submission of affidavits (§§1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under *ex parte* reexamination will be reconsidered by the examiner under the provisions of §1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as set forth in §41.41. Such a reply brief must address each new ground of rejection as set forth in §41.37(c)(1)(vii) and should follow the other requirements of a brief as set forth in §41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§1.130, 1.131 or 1.132 of this title) or other evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

(c) Extensions of time under §1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See §1.136(b) of this title for extensions of time to reply for patent applications and §1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

EFFECTIVE DATE NOTE: At 73 FR 32975, June 10, 2008, §41.39 was revised, effective December 10, 2008. Per a subsequent final rule published at 73 FR 74972, Dec. 10, 2008, the effective date of this action was delayed indefinitely.

For the convenience of the user, the revised text is set forth as follows:

§41.39 Examiner's answer.

(a) *Answer.* If the examiner determines that the appeal should go forward, then within such time and manner as may be established by the Director the examiner shall enter an examiner's answer responding to the appeal brief.

(b) *No new ground of rejection.* An examiner's answer shall not include a new ground of rejection.

§41.41 Reply brief.

(a)(1) Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.

(2) A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See §1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and §41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(b) A reply brief that is not in compliance with paragraph (a) of this section will not be considered. Appellant will be notified if a reply brief is not in compliance with paragraph (a) of this section.

(c) Extensions of time under §1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See §1.136(b) of this title for extensions of time to reply for patent applications and §1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

EFFECTIVE DATE NOTE: At 73 FR 32975, June 10, 2008, §41.41 was revised, effective December 10, 2008. Per a subsequent final rule published at 73 FR 74972, Dec. 10, 2008, the effective date of this rule was delayed indefinitely.

For the convenience of the user, the revised text is set forth as follows:

§41.41 Reply brief.

(a) *Reply brief authorized.* An appellant may file a single reply brief responding to the points made in the examiner's answer.

(b) *Time for filing reply brief.* If the appellant elects to file a reply brief, the reply brief must be filed within two months of the date of the mailing of the examiner's answer.

(c) *Extension of time to file reply brief.* A request for an extension of time to file a reply brief shall be presented as a petition under §41.3 of this part.

(d) *Content of reply brief.* Except as otherwise set out in this section, the form and content of a reply brief are governed by the requirements for an appeal brief as set out in §41.37 of this subpart. A reply brief may not exceed 20 pages, excluding any table of contents, table of authorities, and signature block, required by this section. A request to exceed the page limit shall be made by petition under §41.3 of this part and filed at least ten calendar days before the reply brief is

due. A reply brief must contain, under appropriate headings and in the order indicated, the following items:

(1) Table of contents—*see* §41.37(i) of this subpart.

(2) Table of authorities—*see* §41.37(j) of this subpart.

(3) [Reserved]

(4) Statement of additional facts—*see* paragraph (f) of this section.

(5) Argument—*see* paragraph (g) of this section.

(e) [Reserved]

(f) *Statement of additional facts.* The “statement of additional facts” shall consist of a statement of the additional facts that appellant believes are necessary to address the points raised in the examiner’s answer and, as to each fact, must identify the point raised in the examiner’s answer to which the fact relates.

(g) *Argument.* Any arguments raised in the reply brief which are not responsive to points made in the examiner’s answer will not be considered and will be treated as waived.

(h) [Reserved]

(i) *No amendment or new evidence.* No amendment or new evidence may accompany a reply brief.

§41.43 Examiner’s response to reply brief.

(a)(1) After receipt of a reply brief in compliance with §41.41, the primary examiner must acknowledge receipt and entry of the reply brief. In addition, the primary examiner may withdraw the final rejection and reopen prosecution or may furnish a supplemental examiner’s answer responding to any new issue raised in the reply brief.

(2) A supplemental examiner’s answer responding to a reply brief may not include a new ground of rejection.

(b) If a supplemental examiner’s answer is furnished by the examiner, appellant may file another reply brief under §41.41 to any supplemental examiner’s answer within two months from the date of the supplemental examiner’s answer.

(c) Extensions of time under §1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See §1.136(b) of this title for extensions of time to reply for patent applications and §1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

EFFECTIVE DATE NOTE: At 73 FR 32976, June 10, 2008, §41.43 was removed, effective December 10, 2008. Per a subsequent final rule published at 73 FR 74972, Dec. 10, 2008, the effective date of this action was delayed indefinitely.

§41.47 Oral hearing.

(a) An oral hearing should be requested only in those circumstances in which appellant considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided on the briefs without an oral hearing will receive the same consideration by the Board as appeals decided after an oral hearing.

(b) If appellant desires an oral hearing, appellant must file, as a separate paper captioned “REQUEST FOR ORAL HEARING,” a written request for such hearing accompanied by the fee set forth in §41.20(b)(3) within two months from the date of the examiner’s answer or supplemental examiner’s answer.

(c) If no request and fee for oral hearing have been timely filed by appellant as required by paragraph (b) of this section, the appeal will be assigned for consideration and decision on the briefs without an oral hearing.

(d) If appellant has complied with all the requirements of paragraph (b) of this section, a date for the oral hearing will be set, and due notice thereof given to appellant. If an oral hearing is held, an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. A hearing will be held as stated in the notice, and oral argument will ordinarily be limited to twenty minutes for appellant and fifteen minutes for the primary examiner unless otherwise ordered.

(e)(1) Appellant will argue first and may reserve time for rebuttal. At the oral hearing, appellant may only rely on evidence that has been previously entered and considered by the primary examiner and present argument that has been relied upon in the brief or reply brief except as permitted by paragraph (e)(2) of this section. The primary examiner may only rely on argument and evidence relied upon in an